

REMARKS

I. INTRODUCTION

Claims 1-15, 39, 75 and 109 are presently under consideration in the present application

II. REJECTION UNDER 35 U.S.C. § 103 SHOULD BE WITHDRAWN

Claim 109 stands rejected under 35 U.S.C. §102(b) as being allegedly anticipated by U.S. Patent No. 4,056,724 issued to Harte (the "Harte Patent"). Claims 1-4, 39 and 75 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 5,191,879 issued to Krauter (the "Krauter Patent"), in view of U.S. Patent No. 7,014,966 issued to Pawloski et al. (the "Pawloski Patent"). Claims 5-15 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over the Krauter Patent in view of the Pawloski Patent, and further in view of U.S. Patent No. 6,552,794 issued to Garini (the "Garini Patent").

Applicants respectfully assert that Harte Patent fails to disclose the subject matter recited in independent claim 109. Regarding the rejections of independent claims 1 and 75, and the claims which depend therefrom, since the Pawloski Patent is being antedated as provided herein, Applicants respectfully assert that the Krauter Patent (without being combined with the Pawloski Patent), even if combined with the Garini Patent does not render the subject matter in such claims anticipated or obvious. The detailed reasons for such assertions are provided herein below.

A. REJECTION OF CLAIM 109

Applicants' invention, as recited in independent claim 109, relates to a confocal microscope lens arrangement, which comprises, *inter alia*:

a lens assembly including a plurality of lenses, wherein a **first lens of the plurality of lenses is an aplanat lens, wherein a second lens of the plurality of lenses is a plano-convex lens, wherein the first lens of the plurality of lenses is closer to a focal point of the lens assembly than the second lens of the plurality of lenses, and wherein the first lens of the plurality of lenses is the closest lens of the plurality of lenses to the focal point of the lens assembly.**

The Harte Patent relates to a lens type fluorometer arrangement.

The optical system of the fluorometer is developed within an opaque block 104 of plastic selected because of its dimensional and thermal stability. (See Harte Patent, col. 8, lns. 51-61). The system of the Harte Patent generally consists of three major optical systems: an illumination optical system 105 for supplying excitation light to the sample; a collection optical system 106 for receiving fluorescent output from the sample; and a reference level optical system 107 for periodically establishing and checking zero and preset intensity levels. (See *id.*, col. 8, lns. 62-68).

As described in the Harte Patent, the illumination optical system 105 consists of lamp 110, condensing lens 111, excitation filter 112, chopper 113 and its lens system 114a and 114b, as driven by an electric synchronous motor 115 and focusing lens 116 for imaging excitation light onto a test stage 150 including sample 118. The collection optical system 106 consists of a collecting lens 120, emission filter 121, and photodetector lens 123 which images the sample member surface onto a photodetector 124. The reference level optical

system 107 consists of a beam-splitter 130, a turning mirror 131, chopper 113 and associated reference lens system 133, a diffusing screen 134, a portion of which is developed by lens 135 and reinserted at beam splitter 136 into the collection optical system 106. Rotation of the chopper 113 causes light to pass alternately through the illumination optical system 105 or through the reference optical system 107. Thus, the output at the detector is an alternating signal during one period of which the intensity of the excitation source is measured while the other period measures the fluorescent output. (See *id.*, col. 8, Ins. 62-68).

It is respectfully submitted that the Harte Patent does not disclose a confocal microscope lens arrangement which comprises, *inter alia*, a first lens of a plurality of lenses (of a lens assembly) *that is the closest of the lenses to a focal point of the lens assembly* is an aplanat lens, as recited in independent claim 109.

The Examiner contends that the Harte Patent, at col. 9, Ins. 26-39 thereof, describes an aplanat lens, and also points to lenses 114a, 114b of the Harte Patent... as allegedly being such lenses. (See Office Action dated February 20, 2009, p. 2, para. 2) However, Applicants respectfully assert that the Harte Patent has absolutely no mention of the aplanat lenses in such section or in any other section thereof. Accordingly, it is respectfully asserted that the Harte Patent fails to disclose that the first lens of the lenses of the lenses is an aplanat lens, as recited in independent claim 109. Moreover, there is certainly no disclosure in the Harte Patent that any aplanat lens is the closest of the plurality

of lenses to the focal point of the lens assembly, as also recited in independent claim 109.

Accordingly, Applicants respectfully submit that the Harte Patent does not render the subject matter recited in independent claim 109 anticipated under 35 U.S.C. § 102(b). Thus, withdrawal of the rejection of claim 109 under 35 U.S.C. § 102(b) is respectfully requested.

B. REJECTIONS OF CLAIMS 1-15, 39, 75

The present application was filed as a U.S. national phase application of International Patent Application PCT/US2004/001499 which was filed on January 21, 2004 (the "International Application"). The International Application claims priority from provisional U.S. Patent Application Serial No. 60/441,558 which was filed on January 21, 2003 (the "Priority Application"). Applicants respectfully assert that the Priority Application includes the subject matter recited in originally filed and presently pending independent claims 1 and 75. (See, e.g., Priority Application which is attached herewith, claims 1 and 75). Accordingly, the effective filing date the present application is the filing date of the Priority Application, i.e., January 21, 2003.

The Pawloski Patent was filed with the U.S. Patent and Trademark Office on *September 2, 2003*, which is the 35 U.S.C. § 102(e) effective filing date of the Pawloski Patent.

Thus, as the Examiner shall ascertain, the effective filing date of the present application (i.e., January 21, 2003) is earlier than the § 102(e) effective filing date of the Pawloski Patent (i.e., September 2, 2003). Therefore, it is

respectfully asserted that the Pawloski Patent is not an appropriate § 102(e) reference for rejecting independent claims 1 and 75, and the claims which depend therefrom under 35 U.S.C. § 103(a).

Further, without combining with the Pawloski Patent, the Krauter Patent, taken alone or in combination with the Garini Patent, fails to teach or suggest the subject matter recited in independent claims 1 and 75 and the claims which depend therefrom, and the Examiner does not contend that they do.

Therefore, Applicants respectfully assert that the Pawloski Patent is not an effective prior art reference for rejecting independent claims 1 and 75 and the claims which depend therefrom, and it cannot be combined with the Krauter Patent, taken alone or in combination with the Garini Patent, which on their own fail to teach or suggest the subject matter recited in independent claims 1 and 75. Thus, the § 103(a) rejection of these claims and the claims which depend therefrom should be withdrawn.

III. CONCLUSION

In light of the foregoing, Applicants respectfully submit that the pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited. The Examiner is invited to contact the undersigned to expedite the prosecution of this application if any issues remain outstanding.

Respectfully submitted,

Dated: July 21, 2009

By: 

Gary Abelev
Patent Office Reg. No. 40,479

DORSEY & WHITNEY, L.L.P.
250 Park Avenue
New York, New York 10177

Attorney(s) for Applicant(s)
(212) 415-9371

4811-0588-6980\1